

Hearing:
January 11, 2005

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
March 10, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Verbum AB

Serial No. 78064146

Cori A. Szczucki of Stack & Filpi Chartered for Verbum AB.

Ellen J. Perkins, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).¹

Before Chapman, Bucher and Bottorff, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Verbum AB seeks registration on the Principal Register
of the mark BERLING for goods identified in the
application, as amended, as "computer software for use in
displaying and printing digital typeface designs and
typographic ornaments," in International Class 9.²

¹ Although Ms. Perkins had examined this application early in its prosecution, the Trademark Examining Attorney who handled the application on behalf of the Office from the time of the final refusal through the preparation of the appeal brief was Andrea Koyner Nadelman.

² Application Serial No. 78064146 was filed on May 17, 2001 based upon applicant's allegation of use in commerce at least as early as September 30, 1991.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register the proposed mark based upon the ground that the it merely describes the involved goods pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Both applicant and the Trademark Examining Attorney have fully briefed the case, and appeared at an oral hearing conducted before the Board on January 11, 2005.

We reverse the refusal to register.

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, if it immediately conveys information of a significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services with which it is used or is intended to be used. A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question of whether a particular term is merely descriptive is not decided in the abstract. Rather, the proper test in determining whether a term is merely

descriptive is to consider the mark in relation to the goods for which registration is sought, the context in which the mark is used or is intended to be used, and the possible significance that the mark is likely to have on the average purchaser encountering the goods in the marketplace. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); and In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995).

Applicant and the Trademark Examining Attorney agree that the sole issue on appeal herein is whether applicant's mark BERLING is merely descriptive of "computer software for use in displaying and printing digital typeface designs and typographic ornaments." However, while looking at the same record, they have reached diametrically opposed conclusions.

The Trademark Examining Attorney takes the position that the term BERLING is not arbitrary but rather is the name for a particular, well-known typeface and, therefore is merely descriptive of the identified software, and that consumers will immediately understand that applicant's software features the Berling typeface, a particular genus of font type and, therefore, that the mark identifies a key

feature of the goods. In support of her position, she has introduced webpages in which the term BERLING is used to identify for sale a particular computer "font."

By contrast, applicant contends that the term BERLING distinguishes applicant's goods from those of other type foundries, as it is a distinctive typeface design that has the characteristics of an "Old Style," roman design. Applicant states that the term BERLING has long been recognized as a mark for a typeface design and that the involved goods, computer software, are used to create this typeface design.

In opposition to the refusal, applicant has made of record the following: (1) the declaration of William Davis, then Vice President of Marketing for Agfa Monotype Corporation; (2) screen shots of the www.fonts.com website where consumers can license and download the BERLING font; (3) copies of third-party certificates of registration for a number of different fonts; (4) a dictionary definition of the term "Old Style" as it relates to typography; (5) pages of the Creative Alliance 9.0 booklet illustrating the BERLING mark; and (6) pages of the Encyclopedia of Type Faces illustrating the BERLING mark.

As stated above, applicant put into the record the declaration of William Davis, Vice President of Marketing for Agfa Monotype Corporation.³ Mr. Davis discusses in some detail the evolution of typographic styles that remain dependent upon the limitations and capabilities of the printing technologies of the period.

In short, since the invention of movable type in 1450, through hot metal typesetting and phototypesetting equipment, all the way to today's digital displays, type designers have adapted letterforms and layouts to take advantage of the unique possibilities presented by their respective output devices.⁴

³ Applicant, Verbum AB, has granted Agfa Monotype a license to use, distribute and further license the mark BERLING and the goods associated with that mark.

⁴ The use of the same trademark can be seen as applied to the various media as well. For example, HELVETICA is a well-known, contemporary font referenced repeatedly by applicant:

- ❑ HELVETICA [Reg. No. 0825989] for "printing type" in International Class 6, and "matrices for typographical casting machines, and for font plates for phototypesetting machines," in International Class 7 [first use as of **1962**];
- ❑ HELVETICA [Reg. No. 1203430] for "records of typeface encoded on a data medium for use in a phototypesetter or photoprinter" in International Class 9 [first use as of **1978**];
- ❑ **Helvetica** [Ser. No. 78566576] for "software for type fonts; downloadable software containing type fonts; software for generating, displaying, and printing fonts; data carriers with software for type fonts; data carriers with type fonts; and computer-readable media with computer-executable instructions for generating, displaying, and printing type fonts," in International Class 9 [first use as of **1985**].

Consistent with dictionary definitions of the word, "typeface" as used in applicant's identification of goods refers to "the size and style of the letter or character on the type."⁵ The word "face" used in this context emphasizes that it is the particular collection of features by which a character's design is recognized. According to applicant, characters within the same typeface are all related by common design elements.

Given the technological advances of the past several decades, and particularly with the advent of personal computers, most type designers now create digital typeface designs for viewing on a computer screen and placing the same characters onto paper with a peripheral printing device. As noted by Mr. Davis:

" ... Instead of engraving the shape of a character into a metal matrix, a modern type designer creates a digital typeface design by writing lines of code, i.e., computer software. A computer 'reads' the software code and generates the image of the typeface on the screen. Since the computer reads the computer program automatically, this process usually occurs unbeknownst to the common user. Therefore, the computer software, acting as a modern day printing block, provides the means by which the image of a font becomes visible. And similarly, the name assigned to the resulting image of the font functions as a source indicator."

⁵ We take judicial notice of this definition from The American Heritage Dictionary of the English Language (1975).

The computer programs that generate digital typeface designs are commonly referred to as "fonts." Even before the advent of computers, however, a "font" referred to a particular collection of characters of a typeface having unique parameters.⁶ The dictionary shows that the word "font "(or "fount") is derived from the word "foundry," where, originally, metal type was cast.⁷

Currently, relevant consumers are likely to encounter the term BERLING used in connection with the relevant goods on a website, such as the one that follows, *infra*. Such consumers will likely know that the term BERLING identifies a font, i.e., computer software that generates a digital representation of a particular typeface design. A consumer licenses the BERLING font by clicking on the term BERLING™ displayed on the webpage. After paying the appropriate fee, the consumer is able to download the BERLING font onto her personal computer. Once downloaded, the consumer may

⁶ The Board does not take judicial notice of registrations in the United States Patent and Trademark Office (USPTO). See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974); *Cities Service Company v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); and *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). However, given the unusual circumstances of this case, we note that the word "font" first showed up in listing of goods for "typeface" in trademark applications filed with the USPTO in the early-1970's, with a frequent identification of goods of that period reading as follows: "typeface recorded on a font plate or a data medium for use in typesetting and printing."

type characters on her computer screen using the BERLING font and print those characters out with a computer printer.



Of course, the same could be said of a consumer encountering any font on a website, including the Centaur®, Cumberland®, Garth Graphic®, Rotis®, Thorndale® and Utah® fonts. Applicant attached federal certificates of

⁷ Again, we take judicial notice of this definition from The American Heritage Dictionary of the English Language (1975).

⁸ As stated above, applicant put a copy of this website into the record <http://www.fonts.com/FindFonts/detail.htm?pid=202245>

trademark registration for these fonts to its Request for Reconsideration.⁹

It appears as if the Trademark Examining Attorney held strongly to her position herein based upon the misapprehension (apparently shared by several different Trademark Examining Attorneys who prosecuted this application) that the names of long-standing typefaces, as well as the resulting digital fonts of the same name (e.g., that one sees daily on the pull-down menus of computer word processing applications) must necessarily be in the public domain.

At the oral hearing, applicant's counsel pointed out that there are some such terms that long ago passed into the public domain (e.g., "Garamond" - named after Claude Garamond, 1480-1561). However, the names of some other well-known fonts, such as Helvetica®, Arial®, and Times New Roman®, are proprietary terms for digital fonts legally used only under appropriate licenses.

According to Mr. Davis, the Berling font belongs within a genus of font types known as "Old Style":

⁹ Agfa Monotype Corporation is listed as the owner of the following federal registrations: CENTAUR [Reg. No. 1592796], CUMBERLAND [Reg. No. 2567581], GARTH GRAPHIC [Reg. No. 2674767], ROTIS [Reg. No. 2686379], THORNDALE [Reg. No. 2570268] and UTAH [Reg. No. 2440715].

"As typeface designs have evolved, general methods of categorizing those designs have emerged. One such category is Old Style. As defined by Desktop Publishing Old Style is 'a style of font developed by Renaissance typographers to replace the Blackletter style of type. Based on ancient Roman inscriptions, these fonts are generally characterized by low contrast between thick and thin strokes, bracketed serifs, and a left-leaning axis or stress.' ... Berling, Garamond, Bembo® and Novarese are a few of the fonts in this class.

As to the history of this typeface prior to the advent of computers, Mr. Davis explained the Berling typeface as follows:

"The Berling font has inclined and blunt serifs and ascenders that exceed the height of the capital letters This typeface design was originally designed by Karl-Erik Forsberg [in the 1950's] for the Berling typeface foundry, a foundry which is no longer in existence ..."

Accordingly, while Berling may not be as well known to the average user of a personal computer as are Helvetica® or Times New Roman®, it appears to have had a similar history as a source identifier, and as described by the Trademark Examining Attorney in her brief, does indeed "bear[] "a logical relationship to the type font provided

by the applicant's software."¹⁰

While the Trademark Examining Attorney, in her brief, describes applicant's attempt to distinguish the facts of In re Gyulay, *supra*, from the instant case as representing a "faulty syllogism," we find a degree of circuitous logic in the arguments of the Trademark Examining Attorney:

As stated previously herein, the applicant's mark is for software that produces a particular genus of font type ... The applicant has not demonstrated that the mark is anything but merely descriptive of its goods. The mark immediately names a specific genus of font type, namely, a font type provided by the applicant's software, and does nothing else..."

While the genus of this particular font may be deemed to be "serif," "roman," or "Old Style," etc., we find that applicant has demonstrated convincingly that the term BERLING is a source identifier for the involved computer software. Moreover, the Trademark Examining Attorney has not made a *prima facie* case that the proposed mark is merely descriptive. See In re Gyulay, *supra*.

We find persuasive the declaration of William Davis that trademarks have been important to typeface designers

¹⁰ Applicant's counsel confirmed at oral hearing that applicant has held exclusive, contractual rights to this trademark for typefaces since long before the claimed dates of first use for computer software.

from the time of the manuscript calligraphy of the fifteenth century, and that trademarks continue to be critical to the digital typeface designers and type foundries of the twenty-first century.

In fact, in addition to its rebuttal of the Trademark Examining Attorney's position with a detailed understanding of hundreds of years of history of typeface designs, applicant mentioned during oral argument the intellectual property law challenges facing typeface designers and foundries within applicant's industry. While these details as to the limitations of copyright and design patent protections available to digital typeface designers and type foundries are clearly not determinative of the result herein, they do highlight the significance of applicant's argument that affirming the Trademark Examining Attorney on this record would fly in the face of "hundreds of registered trademarks for font names ..." (Applicant's reply brief, p. 5), including many with historical ties to preexisting typefaces.

Decision: The refusal to register, based upon the ground that the proposed mark merely describes the involved goods pursuant to Section 2(e)(1) of the Trademark Act, is hereby reversed.